



204,896

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Friedman Examiner: Jenise E. Jackson

Application Number: 09/854,307 Group Art Unit: 2131

Filing Date: May 11, 2001

Title: SYSTEM, METHOD AND APPARATUS FOR
ESTABLISHING PRIVACY IN INTERNET
TRANSACTIONS AND COMMUNICATIONS

STATEMENT OF FILING BY EXPRESS MAIL 37 C.F.R. SECTION 1.10

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

1. Introductory Comments

A. Claims 1-32 and 43-52 are pending in this application. Claims 1, 16, 22, 26, 30-32, 43, and 47 are independent claims.

B. In an Office Action dated April 6, 2007, all of the pending claims were finally rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Number 6,275,824 to O'Flaherty.

C. In addition, on page 15, paragraph 44 of the present Office Action, in response to the previously submitted Amendment filed January 8, 2007, it is asserted that

“the features upon which applicant relies (i.e., a subscriber maintains her own personal profile on her PAD) are not recited in the rejected claim(s)”.

D. Further, on pages 15-16 of the present Office Action, paragraph 45, it is stated that:

“The Applicant argues O’Flaherty lacks a PAD having memory for storing unique privacy subscriber identification data corresponding to a subscriber to the system which uniquely identifies the PAD with the subscriber Applicant’s arguments fail to comply with 37 C.F.R. 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references”.

E. Prior to the Amendment filed January 8, 2007, the Appellant and his attorneys conducted a personal interview at the U.S. Patent and Trademark Office with Examiner Jackson as well as Examiner Syed Zia on December 7, 2006, a copy of the Interview Summary being attached herewith as Exhibit A. We note that the Interview Summary apparently was, for a time, inadvertently omitted from the official electronic application record. As is noted in the Interview Summary, the claimed invention was discussed as well as amendments to the claims “to provide more specific limitations with respect to” the invention.

F. In the Amendment filed January 8, 2007, Appellant complied in good faith to enter further specific limitations in accordance with the terms discussed during the Interview of December 7, 2006. After receipt of the present Office Action, mailed April 6, 2007, the Appellant and his attorneys conducted a telephone interview with Examiner Jackson and

Examiner Syed Zia on June 12, 2007 to discuss the issues raised by the present Office Action, as well as the claimed invention and the Amendment filed January 8, 2007.

G. The Appellant submitted drawing revisions in the previous Amendment filed January 8, 2007, yet these drawing revisions have not been acknowledged in the present Office Action.

H. The Appellant submitted an Information Disclosure Statement and references on October 18, 2006 for consideration by the Office, yet this Information Disclosure Statement and references have not been acknowledged in the present Office Action.

2. Appellant Respectfully Submits that:

A. O'Flaherty fails to disclose, teach, or suggest every element, step, and/or feature of the claims currently presented in the application, and so the pending claims are patentable over O'Flaherty under 35 U.S.C. § 102(b) and are in condition for allowance;

B. the feature upon which Appellant relies to distinguish over O'Flaherty (i.e., that a subscriber maintains her own personal profile on her PAD) are indeed recited in the rejected claim(s);

C. that the Appellant's arguments do comply with 37 C.F.R. 1.111(b);

D. that the drawing revisions were proper as filed and merit acknowledgement as constituting part of the record of the present application on appeal;

E. that the Information Disclosure Statement and references were properly and timely submitted on October 18, 2006 in advance of the present Office Action, and therefore merit consideration and acknowledgement as part of the record of the present application on appeal; and

F. that the pending claims are patentable and in condition for allowance over the references submitted with Information Disclosure Statement and references on October 18, 2006.

3. Rejection of the Pending Claims in View of O'Flaherty

In the amendment filed in the Office on January 8, 2007, Appellant pointed out the flaws in the Examiner's grounds of rejection. The Appellant argued that the pending claims are patentable over O'Flaherty, in view of the numerous limitations previously submitted and entered as amendments to the pending claims.

In particular, the claims have been amended to clearly recite features which O'Flaherty cannot be reasonably interpreted to disclose, and upon which the anticipation rejection cannot properly be maintained.

For example, as to independent claim 1, on page 2, paragraph 3 of the Final Office Action, it is stated that:

“O'Flaherty discloses ... each PAD including memory for storing unique privacy subscriber identification data corresponding to a subscriber to the system (see col. 5, lines 1-38).

The cited section of O'Flaherty consists of two and one-half paragraphs describing a kiosk implementation with a smart card or loyalty card, consumer input of data sharing and retention preferences, and operation of a data warehousing system.

Nowhere in O'Flaherty is there any disclosure of “unique privacy subscriber identification (PSID) data”, as required by Appellant's amended claim 1.

In a further example, regarding independent claim 43, on page 12, paragraph 34 of the Final Office Action, it is stated that:

“O’Flaherty discloses an XML privacy service provider ... a plurality of private XML subscriber data files ... (see col. 4, lines 61-67, col. 5, lines 1-16)”

The cited section of O’Flaherty consists of one long paragraph which refers generally to use of the Internet “via a suitable browser plug-in 128” and then continues to describe a kiosk implementation with a smart card or loyalty card.

Nowhere in O’Flaherty is there any disclosure of Extensible Mark-up Language (XML) files or devices, as recited in amended claim 43. The mere mention of the Internet, a browser, or a browser plug-in by O’Flaherty does not equate to XML or its use, since XML is distinct from the more widely used HyperText Mark-up Language (HTML) commonly employed on websites and viewable with Internet browsers. There is simply no explicit or implicit technical basis to support the assertion of relevance.

Independent claims 1, 16, 22, 26, 30-32, 43, and 47 were previously amended to clarify that the present invention operates in a distributed environment in which each of a number of subscribers has a personal access device and each personal access device (PAD) interacts in a system with a privacy provider, a privacy network, and a plurality of vendors connected to a wide area network, and conducts a transaction with privacy for a subscriber using the PAD.

Each PAD has memory for storing unique Privacy Subscriber Identification (PSID) data which corresponds to a system subscriber and that uniquely identifies the PAD, and thereby the subscriber. Each PAD also includes a profile, at least a portion of which is stored on a Privacy Service Provider (PSP) which acts as the privacy provider. Each of the vendors must be registered with a Privacy Shield Network (PSN) as the privacy network in order for the vendors to conduct transactions involving the subscriber.

Under conditions dictated by the subscriber's profile (as established by the subscriber), a transaction is conducted either automatically or manually, and a registered vendor (RV) involved in the transaction has communications through the PSN (the network) to complete the transaction but without ever gaining access to the personal data of the subscriber, thereby preserving the privacy of the subscriber throughout the transaction. No such system exists today, to the best of Appellant's knowledge, and it is certainly not disclosed or suggested by O'Flaherty.

As noted above, Appellant's system is based on a distributed database, where each subscriber maintains, controls, and possesses her own personal profile on her PAD. According to the Online Computing Dictionary which may be found at <http://www.computer-dictionary-online.org>, a distributed system is "a collection of (probably heterogeneous) automata whose distribution is transparent to the user so that the system appears as one local machine. This is in contrast to a network, where the user is aware that there are several machines, and their location, storage replication, load balancing and functionality is not transparent. Distributed systems usually use some kind of client-server organization".

In contrast, O'Flaherty is concerned with maintaining a single centralized database in possession by just one entity with user information physically stored in one place. According to Wikipedia, found at http://en.wikipedia.org/wiki/Main_Page, a centralized system is "one in which most communications are routed through one [as in O'Flaherty] or more major central hubs. Such a system allows certain functions to be concentrated in the system's hubs [or a single hub as in O'Flaherty], freeing up resources in the peripheral units [e.g., kiosks]. Another benefit of centralization is the ease of maintaining accurately updated lists of data that can be easily accessed from all points [e.g., kiosks and mailing list subscribers]. Centralization's weaknesses are centered around the system's heavy reliance on a few central components; if the system's

hubs [or single hub as in O'Flaherty] are put out of operation, either accidentally or through hostile action, the system and its peripheral components are severely affected".

This definition describes the operation of the system in O'Flaherty. Each of O'Flaherty's customers (e.g., subscribers) has an assigned set of rows and/or columns where privacy preferences can be entered from a remote location by the customer. The entity maintaining the centralized database continues to add transaction information that define the customers' buying patterns. The information in the centralized customer database can then be **sold to telemarketers, direct mail merchants or otherwise used** by the maintaining entity, in accordance with the preferences, (if any), entered by the customer. The centralized system of O'Flaherty is directly contrary to that claimed by Appellant which remains under the control of the subscriber.

In one embodiment of O'Flaherty, the customer is provided with a loyalty card, or the like, on which the customer's current privacy preferences, as recorded in the lines and columns of the centralized database, are stored. However, there is no way by which the customer can change the preferences on the loyalty card except by interactively engaging the card with a kiosk or other terminal that is in communication with the centralized database. Obviously, the customer in the O'Flaherty system cannot "read" her preferences from the card without a terminal monitor that is in communication with the centralized database.

This system disclosed and the methods of operation taught by O'Flaherty would not suggest to one of ordinary skill in the art the Appellant's PAD upon which the user enters and maintains her own privacy profile. Neither does O'Flaherty suggest giving the subscriber the autonomy of maintaining a **subscriber-determined portion** of the subscriber's profile with a privacy service provider (PSP) as required by Appellant's claims.

Likewise, one having ordinary skill in the art would not look to O'Flaherty for the elements, steps, and features of pending claims 1-32 and 43-52. O'Flaherty lacks:

(1) a PAD having memory for storing unique Privacy Subscriber Identification (PSID) data corresponding to a subscriber to the system which uniquely associates the PAD with the subscriber,

(2) with the requirement that each PAD also includes the subscriber's profile,

(3) at least a portion of which is stored on a Privacy Service Provider (PSP) which acts as the privacy provider, and

(4) with the requirement that vendors must be registered with a Privacy Shield Network (PSN) as the privacy network in order for the vendors to conduct transactions involving the subscriber, such that,

(5) under conditions dictated by the subscriber's profile, a transaction is conducted either automatically or manually, and

(6) a registered vendor involved in the transaction has communications with the PSN to complete the transaction and without access to personal data of the subscriber, thereby preserving the privacy of the subscriber throughout the transaction.

Accordingly, in view of at least these recited features of privacy subscriber identification (PSID) data and XML as recited in the presently pending claims, an anticipation rejection cannot be supported and is an improper basis for rejecting the claims.

4. The Claimed Features are Clearly Recited and Have Patentable Weight to Distinguish the Pending Claims over O’Flaherty

Despite the assertion to the contrary on page 15, paragraph 44 of the Final Office Action, the Appellant submits that the features upon which the Appellant relies (e.g., that a subscriber maintains her own personal profile on her PAD) are indeed recited in the rejected claims.

In particular, each of independent claims indeed recites this feature. Specifically, independent claim 1 recites a “portable PAD storing a subscriber profile including information related to the subscriber”. Similar limitations were entered in all of the remaining independent claims:

Independent claim 16 recites “A personal access device (PAD) comprising ... a memory for storing ... a profile of the subscriber”.

Independent claim 22 recites a “portable PAD storing a subscriber profile including information related to the subscriber”.

Independent claim 26 recites “the subscriber’s profile stored in memory of the PAD”.

Independent claim 30 recites “storing a profile of a subscriber in memory of the PAD”.

Independent claim 31 recites “storing a profile of a subscriber in a memory contained in the manually portable housing of the PAD”.

Independent claim 32 recites “storing a profile of the subscriber in a memory of the PAD”.

Independent claim 43 recites “a memory in the PAD ... for storing a subscriber profile”.

Independent claim 47 recites a “PAD [including] ... a memory device ... for storing a subscriber profile”.

Therefore, since each independent claim recites, in one form or another, that a subscriber maintains her own personal profile on her PAD, this limitation presented in each of the claims has patentable weight and also patentably distinguishes the pending claims over O'Flaherty.

5. The Previous Amendment Complies with 37 C.F.R. 1.111(b)

Despite the assertion on pages 15-16, paragraph 45 of the Final Office Action, the previous amendment and the arguments presented therein indeed comply with 37 C.F.R. 1.111(b) because they specifically point out how the language of the claims patentably distinguishes the respective claims from O'Flaherty.

In particular, in the Amendment filed January 8, 2007, the Appellant distinctively and specifically pointed out at least one novel feature of the many features which O'Flaherty lacks.

The relevant rule 37 C.F.R. § 1.111(b) states in its entirety:

In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(emphasis added)

The Appellant has clearly and specifically pointed out, in writing in the Amendment of January 8, 2007, that O'Flaherty lacks any unique privacy subscriber identification data corresponding to a subscriber to the system, where such unique privacy subscriber identification data as in the present invention is not stored on the loyalty card or smart card described in O'Flaherty, but instead O'Flaherty stores privacy preferences which are not identical or even comparable to the unique privacy subscriber identification data, as defined by the Appellant.

6. Acknowledgement of Drawing Revisions is Requested.

As noted herein, in the Appellant's last response, that is, the Amendment filed January 8, 2007, drawing revisions were filed, but no acknowledgement was provided in the subsequent Final Office Action. Confirmation of entry of the amended drawings is requested.

7. Consideration of Submitted References is Requested

As noted herein, the Appellant submitted to the Office an Information Disclosure Statement and references on October 18, 2006, but no acknowledgement was provided in the subsequent Final Office Action. The Examiner's acknowledgement of consideration of the Information Disclosure Statement and references is requested.

8. Allowance of the Application over the art of Record, including O'Flaherty and the Submitted References, is Requested

Appellant submits that the pending claims are patentable over the references provided in conjunction with the Information Disclosure Statement filed in the Office on October 18, 2006.

9. Conclusion

In view of the above remarks, Appellant respectfully submits that all of the pending claims in the present application are in condition for allowance. Issuance of a Notice to this effect is hereby requested.

Respectfully submitted,



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Date: September 6, 2007

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EXHIBIT A

Interview Summary

| | | |
|-------------------|-------------------|--|
| Application No. | Applicant(s) | |
| 09/854,307 | FRIEDMAN, SOLOMON | |
| Examiner | Art Unit | |
| Jenise E. Jackson | 2131 | |

All participants (applicant, applicant's representative, PTO personnel):

(1) Jenise E. Jackson.

(3) Anthony J. Natoli. (5) Solomon Friedman.

(2) Thomas E. Spath.

(4) Sherman Lee. (6) Zia Syed.

Date of Interview: 07 December 2006.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☒ Personal [copy given to: 1) ☒ applicant 2) ☒ applicant's representative]

Exhibit shown or demonstration conducted: d) ☒ Yes e) ☐ No.

If Yes, brief description: Shows how PAD works within the PSN system. exhibit 1

Claim(s) discussed: 1443

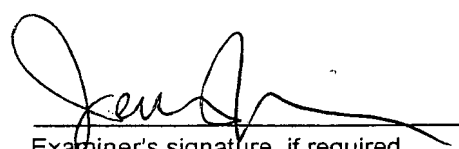
Identification of prior art discussed: _____

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Discussed claimed Invention, and making amendments to independent claims to provide a more specific limitations with respect to invention
(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required



COMMISSIONER FOR PATENTS

Date Stamp as acknowledgement of
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Inventor(s): FRIEDMAN, Solomon

Docket No.: 204,896

USSN: 09/854,307

For: SYSTEM, METHOD AND APPARATUS FOR

Doc. Type: NOTICE OF APPEAL

1. Form PTO/SB/31 Notice of Appeal
2. Form PTO/SB/22 Petition under 37 CFR 1.136(a)
3. Pre-Appeal Brief Request for Review (pgs.)
4. Postcard receipt
5. Check for \$ 250.00 (Notice Appeal)
6. Check for \$ 225.00 (2 Mo. Extension)

Initials: AJN/mw

Date Mailed: September 6, 2007

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